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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/016,566 | 10/30/2001 | Naoki Tagami | 112857-300 | 6359 |
| 29175 | 7590 | 07/17/2006 | | |
| BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135 | | | EXAMINER ROSWELL, MICHAEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2173 | |

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,566

Applicant(s)

TAGAMI ET AL.

Examiner

Michael Roswell

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 7-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,697,840 (Godefroid et al), U.S. Patent No. 6,750,881 (Appelman), and "Sams Teach Yourself America Online in 10 Minutes" by Gene Steinberg, hereinafter Steinberg.

Referring to claims 1 and 7-9, Godefroid discloses in column 5: lines 49-62 a method for interaction within a collaborative environment or user space wherein "[u]sers may initiate a collaborative communication session, invite others to join an existing session, request to participate in an existing session, accept or decline others' requests to join a session, or leave a session." Godefroid further explains in this section that customized admission control policies may require a session initiator's consent or consent of the majority before a user can join a particular collaborative communication session. Such policies inherently require that one or more session participants be notified when the user requests to join a particular user space. Godefroid, however, fails to disclose storage means for storing at least one list of users associated with the user space wherein the list is generated by the first user and includes at least one of a second user denied admission to the user space and a second user granted admission to the user space. Godefroid also fails to disclose determining means for determining whether the second user is denied admission to the user space or granted admission to the user space based on the list of users stored in the storage means. Appelman, however, discloses in column 2: line 47 through 3: line 63 a Buddy List system wherein one or more user lists are stored in a database structure. Appelman further discloses in column 5:

lines 23-49 two types of user-designated lists for restricting communication between a first user and a second user. Said communication can comprise "Buddy Chat Invitations" or other requests to enter a virtual user space. The first type of list allows the second user to contact the first user only if the second user's name appears on a list of permitted users. The second type allows the second user to contact the first user only if the second user's name does not appear on a list of non-permitted users. The two lists are mutually exclusive and advantageously provide an extended degree of privacy to the first user. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the aforementioned teachings of Appelman with Godefroid's invention. In such a combination, users of Godefroid's invention would still be able to request to join an existing session and accept or decline others' requests to join a session as discussed above. Additionally, users already in an existing session would now have the added benefit of only being bothered by requests to join the session if the requesting user is on the list of permitted users or not on the list of non-permitted users. Finally, one would have been motivated to do this in order to increase privacy for users of Godefroid's invention as suggested by Appelman. Furthermore, Godefroid and Appelman fail to explicitly teach a list of predetermined spatial locations in the virtual user space being further stored, where the list of predetermined spatial locations is designated by the first user. Steinberg teaches the use and features of the America Online (AOL) program, identical to the online system of Appelman, who teaches the use of a favorite places list at col. 6, lines 44-51. Steinberg also teaches a list of predetermined spatial locations in the virtual user space being further stored, where the list of predetermined spatial locations is designated by the first user, taught as the ability to store URLs and AOL locations in a "Favorite Places" list, at page 21. The user has the ability to add any location in the virtual space that is designated by a "heart icon", which can be seen in relation to the displayed chat room window

Art Unit: 2173

of page 100, and also related to an online message board, as seen in pages 90-92. Chat rooms and message boards are two well-known virtual spaces, where users come together to interact through the sharing of text and other relevant media. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Godefroid and Appelman before him at the time the invention was made to modify the favorite places list of Appelman to include the chat room and message board virtual spaces as taught by Steinberg. One would be motivated to make such a combination as Appelman and Steinberg teach identical online software.

Referring to claim 2, Godefroid's notifying means must inherently comprise at least one of a visual and an audio notification to a first user. Without such the first user would not be able to respond to requests from a second user to participate in a collaborative communication session.

Referring to claim 13, Godefroid fails to disclose storing a list of predetermined user-designated spatial locations and placing the list in the virtual space in response to instructions from the user. Appelman, however, discloses in column 6: lines 44-51 a method of sharing a user's favorite places with other users of the system. The method comprises the steps of selecting from a list of favorite places and sending invitations for each favorite place to the desired users. The user is thus placing a list of designated spatial locations into the virtual space. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to share favorite places as taught by Appelman in combination with the teachings of Godefroid so that users with similar interests can share information that they may find to be useful or interesting as suggested by Appelman. Steinberg teaches the use and features of the America Online (AOL) program, identical to the online system of Appelman, who teaches the use of a favorite places list at col. 6, lines 44-51. Steinberg also teaches a list of predetermined spatial locations in the virtual user space being further stored, where the list of

predetermined spatial locations is designated by the first user, taught as the ability to store URLs and AOL locations in a "Favorite Places" list, at page 21. The user has the ability to add any location in the virtual space that is designated by a "heart icon", which can be seen in relation to the displayed chat room window of page 100, and also related to an online message board, as seen in pages 90-92. Chat rooms and message boards are two well-known virtual spaces, where users come together to interact through the sharing of text and other relevant media.

Referring to claims 10 and 11, Appelman, as discussed above, discloses in column 5: lines 23-49 two types of user-designated lists for restricting communication between a first user and a second user. Said communication can comprise "Buddy Chat Invitations" or other requests to enter a virtual user space. The first type of list allows the second user to contact the first user only if the second user's name appears on a list of permitted users. The second type, vice-versa, allows the second user to contact the first user only if the second user's name does not appear on a list of non-permitted users. The two lists are mutually exclusive and advantageously provide a degree of privacy to the first user.

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,697,840 (Godefroid et al), U.S. Patent No. 6,750,881 (Appelman), and Steinberg as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 6,212,548 (DeSimone et al).

Referring to claims 5 and 12, Godefroid, Appelman and Steinberg fail to disclose requiring certain entry information by the second user to allow the second user to gain access to a user space occupied by the first user. DeSimone, however, discloses in column 15: lines 1-12 a system and method in which access to a user space is restricted according to entry

information provided by a second user. DeSimone explains in this section that passwords or other keywords may be required before a request for entry to a user space will be honored. The second user, furthermore, could only be aware of said entry information if a first user already occupying the user space distributed the information via some sort of prescreening process as disclosed in column 14: lines 62-67. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to require certain entry information distributed by the first user to the second user to allow the second user to gain access to a user space occupied by the first user as taught by DeSimone in combination with the teachings of Godefroid, Appelman, and Steinberg. It would have been advantageous to do this because it increases the privacy of the user space as suggested by DeSimone in column 14: lines 51-54.

Response to Arguments

Applicant's arguments filed 26 April 2006 have been fully considered but they are not persuasive. Applicant argues that a clear difference exists between the use of preferences in Appelman at the use of lists in the claimed invention, citing the teaching in Appleman in which a user may choose to allow all users to add the original user to buddy lists and invitations, or to block all users from adding the original user to buddy lists and invitations. While this is certainly taught by Appelman, a further reading of the cited passage reveals that a user may grant or deny access to their own user space by selectively adding member names to such access lists, specifically at col. 5, lines 18-40. Furthermore, as stated above, Steinberg teaches a list of predetermined spatial locations in the virtual user space being further stored, where the list of predetermined spatial locations is designated by the first user, taught as the ability to store URLs and AOL locations in a "Favorite Places" list, at page 21. The user has the ability to add any location in the virtual space that is designated by a "heart icon", which can be seen in

relation to the displayed chat room window of page 100, and also related to an online message board, as seen in pages 90-92. Chat rooms and message boards are two well-known virtual spaces, where users come together to interact through the sharing of text and other relevant media.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Roswell whose telephone number is (571) 272-4055. The examiner can normally be reached on 8:30 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Roswell
7/6/2006


TADESSE HAILU
Patent Examiner